

Publication No. 2006/0138102 to Sawada. The Applicant respectfully traverses the rejection because the Official Action has not made a *prima facie* case of obviousness.

As stated in MPEP §§ 2142-2144.04, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some reason, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some reason to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. "The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art." In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). See also In re Fine, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

With respect to independent claims 14, 15, 26 and 27, the prior art, either alone or in combination, does not teach or suggest all the features of the independent claims.

The Official Action contends that Sasaki discloses blocking end portions of a first laser beam emitted from a laser oscillator (71) by a lens (76). However, the Official Action concedes that Sasaki does not teach blocking end portions by a slit. The Official Action further contends that it would have been obvious to one of ordinary skill in the art to have combined the teachings of Sasaki and Tanaka '223 (pgs. 2-3; Paper No. 20110312). It appears that the Official Action is asserting that lens (76) in Sasaki would be replaced by the slit taught in Tanaka '223. The applicant respectfully disagrees for several reasons.

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the results would have been predictable to one of ordinary skill in the art. KSR International Co. v. Teleflex Inc., 550 U.S. 398, 82 USPQ2d 1385 (2007). Moreover, if proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). Also, if the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. In re Ratti, 270 F.2d 810, 123 USPQ 349 (CCPA 1959).

When lens (76) in Sasaki is replaced by a slit such as in Tanaka '223 for blocking end portions of a first laser beam, the beam spot of the laser beam after passing through the focus optical system (74) in Sasaki would differ from what was specifically designed for since one of the two cylindrical lenses (the one arranged perpendicular to lens 75) would necessarily be removed from the focus optical system shown in FIG. 22 in Sasaki. Thus, the resultant optical system would no longer function as intended. This is because the purpose of cylindrical lens (76) is not to block end portions of a first laser beam, as alleged, but to shape and form the beam spots into an elliptical shape (paragraph [0133] of Sasaki). The asserted combination would defeat this intended function. Thus, one of ordinary skill in the art would not have been predictably led to the combination asserted.

With respect to dependent claims 25 and 37, the Official Action contends that the features claimed are disclosed in FIG. 22 of Sasaki and in paragraphs [0132]-[0134] (pg. 5; Paper No. 20110312). However, these do not appear to teach or suggest that an image at the lens (76) and an image on the irradiation surface (36) are in a conjugated relation by the condensing lens, as claimed. Moreover, even assuming *arguendo* that the lens (76) of Sasaki was replaced by a slit as in Tanaka '223, the combination still would not appear to teach or suggest that an image at the lens (76) (or

slit) and an image on the irradiation surface (36) are in a conjugated relation by the condensing lens.

Tanaka '182 and Sawada do not appear to overcome the above deficiencies of Sasaki and Tanaka '223.

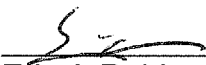
Because Sasaki, Tanaka '223, Tanaka '182 and Sawada do not teach or suggest all the claim limitations, a *prima facie* case of obviousness cannot be maintained with respect to independent claims 14, 15, 26 and 27. Therefore, Applicant believes the rejection of claims 14, 15, 26 and 27 and claims dependent therefrom is not proper.

Accordingly, reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) are in order and respectfully requested.

Should the Examiner believe that anything further would be desirable to place this application in better condition for allowance, the Examiner is invited to contact the undersigned at the telephone number listed below.

The Commissioner is hereby authorized to charge fees under 37 C.F.R. §§ 1.16, 1.17, 1.20(a), 1.20(b), 1.20(c), and 1.20(d) (except the Issue Fee) which may be required now or hereafter, or credit any overpayment to Deposit Account No. 50-2280.

Respectfully submitted,

  
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Eric J. Robinson  
Reg. No. 38,285

Robinson Intellectual Property Law Office, P.C.  
3975 Fair Ridge Drive  
Suite 20 North  
Fairfax, Virginia 22033  
(571) 434-6789